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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,547	11/20/2001	Kazuhiro Nanbu	FUJY 19.187	7570
26304	7590	09/09/2004	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			MCALLISTER, STEVEN B	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,547

Applicant(s)

NANBU ET AL.

Examiner

Steven B. McAllister

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/20/2001</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For instance the claims are unclear because it is unclear what is meant by "enabling an orderer to given an order of purchasing", "agency service trader's place", "purchase target article", "of which respective respective notifications are given via said communication terminal used by the orderer" (it is not clear here whether it is saying that notifications were given by the user or notifications will be sent to the user); "unique to both of every orderer and every purchase ", and "home delivery slip number". This list is not intended to be viewed as exhaustive.

In claims 7 and 19, "notifying said virtual shop of a request for delivering the purchase article" is unclear since it would appear that the shop would send out a request to deliver the purchased article.

In claims 12 and 24, lines 1-4 are unclear.

In claims 8 and 20, "repeatedly" is indefinite.

In claims 8 and 20, "register said virtual shop on a blacklist" is unclear.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 26 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 26 is drawn to disembodied software, which is per se nonstatutory. It is noted that a software program embedded on a tangible computer readable medium is statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 11-17, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buettgenbach et al (2002/0032613), hereafter "613", in view of Walker et al (6,754,636).

As to claims 1 and 13, '613 shows receiving from the virtual shop order data and pickup location data (which the buyer notified the shop of) via a receiving unit (e.g., par. 0040, 0048); issuing identification on the basis of having received the order information

via an issuing unit (e.g., par. 0071); and confirming the identification information via a confirmation unit.

'613 does not explicitly show that the identification information issued to the buyer is unique to both the buyer and transaction. Walker et al show providing identification information unique to the buyer and transaction (e.g., Fig. 22). It would have been obvious to one of ordinary skill in the art to modify the method of '613 as taught by Walker et al in order to provide greater security (for instance, each time a locker is used a new ID number is used, so previous users cannot re-enter it; and losing a tangible item having the number in or on it can result only in the loss of one package rather than the repeated loss of packages).

As to claims 2 and 14, '613 in view of Walker et al show generating the identification information using order information (e.g., Fig. 22). They do not show generating information using a one-way function. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to provide identification based on a one way function in order preserve the integrity of the original data.

As to claims 3 and 15, it is noted that '613 in view of Walker et al show setting the identification information so as to contain numerals of the buyers phone number, comprising using the entire phone number (e.g., par. 54).

As to claims 4 and 16, Walker shows confirming the identification information via a POS terminal.

As to claims 5 and 17, '613 in view of Walker et al show using a smart card.

As to claims 11 and 23, '613 in view of Walker et al show all steps except erasing the data when legal. However, it is notoriously old and well known in the art to erase such data when legal in order to minimize the amount of data held in long term storage and therefore reduce costs.

As to claims 12 and 24, '613 in view of Walker et al show receiving a piece of completion information and notifying the virtual shop of the completion, and notifying a settlement institution of information about payment.

As to claims 25 and 26, it is noted that '613 in view of Walker et al show software performing the recited steps.

Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over '613 in view of Walker et al as applied to claims 1 and 13 above, and further in view of Zarovinsky (2002/0133415).

'613 in view of Walker et al show all elements of the claims except providing a list of receiving locations to the e-shop. Zarovinsky shows the e-shop providing a list of receiving location for the buyer to choose from (par. 48). It is inherent therefore that this information was provided to the e-shop. It would have been obvious to one of ordinary skill in the arts to further modify the method of '613 by providing a list of locations as taught by Zarovinsky in order to ease determining where to ship for the buyer, and to gain more business.

Claims 7-10 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over '613 in view of Walker et al as applied to claims 1 and 13 above, and further in view of "Re: Astropix Wholesale Optics", hereafter "Astropix".

'613 in view of Walker et al show all elements of the claim except notifying of a request for delivery and receiving a tracking number as a reply. Astropix shows these elements. It would have been obvious to one of ordinary skill in the art to further modify the method of '613 by sending a delivery request and receiving a tracking number in order to ensure that the shipment can be tracked.

As to claims 8 and 20, '613 in view of Walker et al and Astropix shows all elements except putting a merchant on a blacklist and notify the customer. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the method of '613 by doing so in order to keep the customer apprised and to avoid bad business dealings in the future.

As to claims 9 and 21, '613 in view of Walker et al and Astropix shows all elements except providing the information when delivery response is received. However, to do so is notoriously old in the art. It would have been obvious to one of ordinary skill in the art to provide such information at the earliest time in order to provide the buyer with the opportunity to plan his time.

As to claims, 10 and 22, it is noted that '613 in view of Walker et al and Astropix shows all elements. It is noted that the server 214 of '613 is located centrally, away from any one shipping agent's location, and that any information sent to or from the agent's location is therefore forwarded by the server to that location.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven B. McAllister

STEVE B. MCALLISTER
PRIMARY EXAMINER

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